

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Huston et al.

Serial No. 10/772,071

Filed: February 4, 2004

For: METHOD AND APPARATUS FOR
MESSAGE DISPLAY ON A GOLF
COURSE

§ Group Art Unit: 2681
§ Examiner: Gregory C. Issing

§ Atty. Dkt. No. 5863-00203

I hereby certify that this correspondence is being
transmitted via facsimile or deposited with the U.S. Postal
Service with sufficient postage as First-Class mail in an
envelope addressed to: Commissioner for Patents, P.O. Box
1450, Alexandria, VA 22313, on the date indicated below.

2/17/05
Date

Pamela Gerik
Pamela Gerik

DECLARATION OF CHARLES D. HUSTON UNDER 37 C.F.R. § 1.131
REGARDING DIMITRIADIS ET AL.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

I, Charles D. Huston, hereby declare and state that:

1. I am a named inventor in the above-identified patent application, which is U.S. Patent Application No. 08/926,293, filed on Sept 5, 1997, which is a continuation of U.S. Patent Application No. 08/366,994 filed December 30, 1994 which is a continuation in part of U.S. Patent Application No. 08/313,718 filed Sept 22, 1994, which in turn is a continuation in part of U.S. Patent Application No. 07/804,368 (U.S. Pat. No. 5,314,093) filed December 10, 1991.
2. In the present application, certain claims have been rejected in reference to U.S. Patent No. 5,664,948 to Dimitriadis et al., which issued on Sept 9, 1997 and was filed on October 11, 1994. The '948 patent also claims priority from U.S. Pat. Nos. 08/282,893 and 08/283,276 both filed on July 29, 1994, but the subject matter cited by the Examiner in this case appears to have been first presented October 11, 1994.

3. In the present application, certain claims have been rejected based on certain subject matter of Dimitriadis et al, namely: "Dimitriadis et al teach the conventionality of providing both position and condition-based advertisement message presentation wherein a GPS-determined position (80) and optionally a condition (440b), is compared to a database resource 90 having advertisement messages correlated with advertisement locations/and/or times . . ." The effective date of this subject matter appears to be October 11, 1994.

4. As supported below, I, along with Darryl Cornish, conceived of the subject matter claimed in the present application within the United States before October 11, 1994. The subject matter includes an apparatus and method of displaying messages to a golfer based on location or activity of the golfer. One embodiment of the subject matter included memory for storing messages and for displaying the different messages based on position on the golf course.

5. Exhibit A attached hereto is a true copy of a screen printout of the Macintosh computer (LC III) that was used to create the captioned application. The "AD CIP" file was created prior to October 11, 1994. The "Get Info" function of the Macintosh reveals that the first drafts of the "Ad Specification," "Ad Claims," and "Ad Abstract" were all created before October 11, 1994. Attached as part of Exhibit A are photographs of the screen showing the "Get Info" results. Exhibit A shows the CIP patent application relating to "Advertising" based on the parent application relating to use of GPS on golf courses was commenced before October 11, 1004.

6. Exhibit B are the printouts of the "Ad Abstract" and the "Ad Claims" listed in the screen printout of Exhibit A. First drafts were created prior to October 11, 1994 as demonstrated by the "Get Info" function (*see Exhibit A*). The "Ad Specification" was also created prior to October 11, 1994.

7. Exhibit C attached hereto is a true copy of a screen printout of the Macintosh computer (LC III) that was used to create the captioned application. Various figures in the "Ad Drawings" file were created prior to October 11, 1994. The "Get Info" function of the Macintosh reveals that the first drafts of the Figs. 5 and 6 were not created before October 11, 1994, but all remaining Figures have first drafts created before October 11, 1994. Of course, several of the Figures are from the parent application. Figure 1 (attached as part of Exhibit C) was created before October 11, 1994 and was "last modified" September 14, 1994, as shown. From Figure 1 and the accompanying text (*see specification pp. 11-12*), messages to the golfer (in the case "Tips") are displayed based on the golfer's location and are stored in memory 25.

8. From at least a time just prior to October 11, 1994 through the filing of the application on December 30, 1994, preparation of the captioned patent application continued. We did not abandon, suppress, or conceal the ideas set forth in the claimed invention during at least the time beginning just prior to October 11, 1994 through the filing of the application on December 30, 1994. One of the drawings of Exhibit C was created in September 1994 and another in November 1994 showing continued work on the preparation of the application.

9. Upon information and belief, it is my informed understanding that diligence in reducing the invention to practice was therefore maintained from at least as early as just prior to October 11, 1994 through the filing of the application on December 30, 1994.

10. I declare that all statements made herein of my own knowledge are true, and that all statements of my own belief are believed to be true, and further that these statements were made with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under the United States Code, Title 18 § 1001, and that such willful false statements may jeopardize the validity of the patent, and any reexamination certificate issuing thereon.

Feb
17 ~~2005~~ 2005
Date


Charles D. Huston